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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/623,914 | 07/21/2003 | Thomas M. Hering | 27708/03905 | 5367 |

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EXAMINER

DUNSTON, JENNIFER ANN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1636

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------|---------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/623,914 | HERING ET AL. | |
| | Examiner | Art Unit | |
| | Jennifer Dunston | 1636 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 8-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 8-34 are pending in the instant application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 8-14, drawn to an isolated polynucleotide encoding CZF-2 protein, classified in class 536, subclass 23.5.
- II. Claims 15-20, drawn to an isolated CZF-1 protein, classified in class 530, subclass 350.
- III. Claims 21-26, drawn to an isolated CZF-2 protein, classified in class 530, subclass 350.
- IV. Claim 27, drawn to an antibody against CZF-1 protein, classified in class 530, subclass 387.1.
- V. Claim 28, drawn to an antibody against CZF-2 protein, classified in class 530, subclass 387.1.
- VI. Claims 29 (as drawn to SEQ ID NO: 1), 30 and 33 (as drawn to SEQ ID NO: 1), drawn to a method of determining the extent of chondrogenesis, comprising assaying for the presence of hybridization between a cell or RNA isolated from a cell and a nucleic acid probe comprising SEQ ID NO: 1 or a fragment thereof, classified in class 435, subclass 6.
- VII. Claims 29 (as drawn to SEQ ID NO: 3), 31 and 33 (as drawn to SEQ ID NO: 3), drawn to a method of determining the extent of chondrogenesis, comprising

assaying for the presence of hybridization between a cell or RNA isolated from a cell and a nucleic acid probe comprising SEQ ID NO: 3 or a fragment thereof, classified in class 435, subclass 6.

VIII. Claims 32 (as drawn to the use of anti-CZF-1) and 34 (as drawn to the use of anti-CZF-1), drawn to a method of determining the extent of chondrogenesis, comprising contacting a cell or protein obtained from a cell with an anti-CZF-1 protein antibody, classified in class 435, subclass 7.1.

IX. Claims 32 (as drawn to the use of anti-CZF-2 antibody) and 34 (as drawn to the use of anti-CZF-2 antibody), drawn to a method of determining the extent of chondrogenesis in a cell, comprising contacting a cell or protein obtained from a cell with an anti-CZF-2 protein antibody, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and Group VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the polynucleotide encoding CZF-2 protein can be used in a materially different process such as the manufacture of purified CZF-2 protein, or for expressing protein to make antibodies.

Inventions Group IV and Group VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the antibody against CZF-1 protein can be used in a materially different process such as the affinity purification of CZF-1 protein, or to supershift CZF-1 complexes in electrophoretic mobility shift assays.

Inventions of Group V and Group IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the antibody against CZF-2 protein can be used in a materially different process such as the affinity purification of CZF-2 protein, or to supershift CZF-2 complexes in electrophoretic mobility shift assays.

The nucleic acids of Group I, polypeptides of Groups II and III, and the antibodies of Groups IV and V are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. The product of each group is not needed to produce the products of the other groups (each of which can be isolated from cells or organisms, made synthetically, and/or are self-replicating without the need for the isolated products of the other groups). Therefore, the inventions of the groups are capable of supporting separate patents.

The inventions of Groups VI-IX are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups VI-IX comprise steps which are not required for or present in the methods of the other groups: hybridizing a probe comprising SEQ ID NO: 1 or a fragment thereof (Group VI), hybridizing a

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probe comprising SEQ ID NO: 3 or a fragment thereof (Group VII), contacting a sample with an anti-CZF-1 antibody (Group VIII), and contacting a sample with an anti-CZF-2 antibody (Group IX). The end results of the methods are different because they depend on the use of different products. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Except for the specific relationships described above, the inventions of Groups I-V and Groups VI-IX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different products of Groups I-V are not necessarily used in or made by the methods of Groups VI-IX.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Searching for any of the products will not necessarily identify the claimed methods. Further, each product requires a separate search of the patent and non-patent literature due to the different structural features of the protein, polynucleotide, or antibody. Further, each protein or nucleic acid sequence requires a separate search of the commercial sequence databases. The search for each method requires a separate search of the patent and non-patent literature to search the method step(s) not shared with any other group. Therefore, the searches are not coextensive, and the additional searching that is required to search more than one group would impose a serious search burden.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

Process claims that depend from or otherwise include all the limitations of the patentable

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product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. § 1.116; amendments submitted after allowance are governed by 37 C.F.R. § 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with the 37 C.F.R. § 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996).

Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. § 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is 571-272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached at 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR, <http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Jennifer Dunston
Examiner
Art Unit 1636

jad

CELINE QIAN, PH.D.
PRIMARY EXAMINER

